APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,935	02/20/2002	Muneki Shimada	SCEY 19.467	6516

26304	7590	07/05/2006	EXAMINER

KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

LEMMA, SAMSON B

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	10/079,935	SHIMADA ET AL.
Office Action Summary	Examiner	Art Unit	
	Samson B. Lemma	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 April 2006</u>.

2a)☒ This action is **FINAL.**　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-4,6-11,13,14,27 and 29-33</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-4,6-11,13,14,27 and 29-33</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date <u>04/10/06</u>.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This office action is in replay to an amendment filed on April 10, 2006.

Claims 5, 12, 16-26 have been previously canceled. Independent claims 15 and

28 are now canceled. New claims 30-33 are added.

Thus, **claims 1-4, 6-11, 13-14,27, 29-33** are pending/examined.

Information Disclosure Statement

2.   Applicants request for the consideration of the Information Disclosure Statement

filed on April 10/2006 is acknowledged. Examiner has reviewed and signed

copies of the IDS submitted.

Response to Arguments

3.   Applicant's remark/arguments filed on April 10, 2006 regarding independent

claims 1, 10, 27, 29 and the dependent claim 9 have been fully considered but

they are not persuasive.

Applicant first argument is based on the limitation in the independent

claim 1, 10, 27 and 29.

Applicant argument is based on the motivation used to combine the two

references used towards the independent claims **1,10, 27 and 29**. Applicant

argued that, the motivation for modifying/combining **Akiyama (U.S. Patent No.**

5,805,699) with Qawami (U.S. Publication No. 2002/0176575) is improper

because it lacks supporting evidence.

Examiner disagrees with this argument, Examiner would point out that It

is not necessary that the reference actually suggest, expressly or in so many

words, the changes or improvements that applicant has made. The text for

combining references is what the references as a whole would have suggested

to one of ordinary skill in the art. See In re Sheckle, 168 USPQ 716 (CCPA

1971) In re McLaghin 170 USPQ 209 (CCPA 1971). In re Young 159 USPQ 725

(CCPA 1968).

 In order to clarify how each and every limitation of the independent claims is

disclosed by the combination of the two references, namely **Akiyama** and

Qawami (Examiner would map each limitation of the independent claims with

the references used in the rejection as follows). **Referring to the independent**

claims 1, 10 and 27, **Akiyama discloses a copy management system,**

comprising:

a storage media, which is stored with predetermined content,[figure 1reference

"1"] **and which is attached with unique media identification information;** [figure

1, reference 2]

a user terminal device, [figure 1, reference 3] **which comprises copy means**

[figure 1, reference 9] **for copying the content stored in the storage media** [figure

1, reference 1] **to a first storage device,**[figure 1, reference 3] (Target storage

medium) and **which transmits device identification information attached to the**

user terminal device.[figure 1, reference 4] (the device identification

information/storage medium identifier) together with the unique media

identification information of the storage media[column 7, lines 42-45](As explained in

the abstract and also column 7, lines 42-45 both the device identification information attached

to the user device/medium identifier shown on figure 1, ref. 4 and the unique media

identification which is shown on figure 2, ref. 2 are transmitted /sent to the central

site/server device which manages licenses for the right to copy software product); a server

device which shown on figure 1, ref. 5) **which transmits copy enabling information**

for enabling copy of content corresponding to the unique media identification

information against the user terminal device corresponding to the device

identification information when receiving the unique media identification

information and device identification information.[Abstract and column 7, lines

39-column 8, line 7]

Akiyama does not explicitly disclose

- deleting the copy enabling information after copying the content.

However, In the same field of endeavor, **Qawami** discloses

- In step 225, a portion of the track is played back. This portion may be in

any of the files that comprise the track. In step 225a, the media unique key

(K.sub.mu) is calculated once again. **In step 225b, the encrypted title key**

stored in local memory is decrypted. Then, in step 225c, the title key is used

to decrypt the content from the buffer of device 15 containing content from the

user area 41 of card memory card 13. **Immediately after the buffer is**

decrypted, the title key is deleted in step 225d and **the media unique key**

is deleted in step 225e. The order of steps 225d and 225e is not important, but

it is important that both keys are only exposed for the time it takes to

completely read/copy a portion of the track. Thus after the track is

read/copied the key is deleted. [Paragraph 0058 and also see claim 1]

The motivation to combine the two references is explained below.

Therefore all the limitations of the independent claims are undoubtedly

disclosed by the combination of the references and the rejection is maintained

until the applicant amend the independent claims and successfully overcome

the rejection without introducing new matters.

The above argument is applicable towards the applicant's argument presented to

the independent claims 29.

The next argument presented by the applicant is towards the dependent claims.

Examiner disagrees with the argument as the dependent claims stands and falls

with the corresponding independent claims.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

5.   **Claims 1-4, 6-11, 13-14, 27 and 29-33** are rejected under 35 U.S.C. 103 (a) as

being unpatentable over Akiyama et al (hereinafter referred as Akiyama) (U.S. Patent

Number:5,805, 699) Date of Patent. (September 8, 1998) in view of Qawami et al

(hereinafter referred to as **Qawami**) (U.S.Patent **2002/0176575 A1**)(Claims priority of

provisional application 60/251,731) (filed on Dec 7, 2000)

6.   **As per claims 1, 3, 10 and 27, Akiyama discloses a copy management**

system, comprising:

a storage media, which is stored with predetermined content,[figure 1reference

"1"] and which is attached with unique media identification information; [figure

1, reference 2]

a user terminal device, [figure 1, reference 3] **which comprises copy means**

[figure 1, reference 9] **for copying the content stored in the storage media** [figure

1, reference 1] **to a first storage device,**[figure 1, reference 3] (Target storage

medium) and **which transmits device identification information attached to the**

user terminal device.[figure 1, reference 4] (the device identification

information/storage medium identifier) together with the unique media

identification information of the storage media[column 7, lines 42-45](As explained in

the abstract and also column 7, lines 42-45 both the device identification information attached

to the user device/medium identifier shown on figure 1, ref. 4 and the unique media

identification which is shown on figure 2, ref. 2 are transmitted /sent to the central

site/server device which manages licenses for the right to copy software product); a server

device which shown on figure 1, ref. 5) **which transmits copy enabling information**

for enabling copy of content corresponding to the unique media identification

information against the user terminal device corresponding to the device

identification information when receiving the unique media identification

information and device identification information.[Abstract and column 7, lines

39-column 8, line 7]

　　　Akiyama does not explicitly disclose

- deleting the copy enabling information after copying the content.

However, In the same field of endeavor, **Qawami** discloses

- In step 225, a portion of the track is played back. This portion may be in

any of the files that comprise the track. In step 225a, the media unique key

(K.sub.mu) is calculated once again. **In step 225b, the encrypted title key**

stored in local memory is decrypted. Then, in step 225c, the title key is used

to decrypt the content from the buffer of device 15 containing content from the

user area 41 of card memory card 13. **Immediately after the buffer is**

decrypted, the title key is deleted in step 225d and **the media unique key**

is deleted in step 225e. The order of steps 225d and 225e is not important, but

it is important that both keys are only exposed for the time it takes to

completely read/copy a portion of the track. Thus after the track is

read/copied the key is deleted. [Paragraph 0058 and also see claim 1]

It would have been obvious to one having ordinary skill in the art, at the time

the invention was made, to combine the features of deleting the copy enabling

information/key after copying the content as per teachings **Qawami** into the

method as taught by **Akiyama** in order to limit the number of times the content

can be used.

7.   <u>As per claims 14 and 29,</u> **Akiyama** discloses a copy management method

comprising the steps of:

transmitting/receiving device identification information which is attached to

a device that includes a user terminal device, and media identification

information uniquely attached to a storage media stored with predetermined

content, the media identification information and the device identification

information being sent from the user terminal device; [Column 7, lines 42-45]

a step of detecting whether the received media identification information is

registered in a database registered with media identification information of

storage media having the content thereof copied in a state of being associated

with device identification information; .[column 7, lines 46-47; figure 7,

reference "S12"] and **a step of transmitting copy enabling information for**

enabling copying of the content to a user terminal device when

non-registration of the media identification information

is detected.[figure 7, reference "S14" and column 7, lines 46-47; figure 7,reference

"S12"](Before the copy enabling information for enabling copying of the content is sent to a

user terminal device or the target device, the legitimacy of the media identifier/software

identifier is checked at the server by checking the registration as explained on column 7, lines

46-47, this meets the recitation of either checking whether the registration of the identifier or

checking the non-registration of the identifier depending on the design choice. Then the

processing of transmitting the copy enabling information from the central server to the

terminal device depending on the outcome of verification of the registration proceeds as

shown on figure 7, reference S13-S17 and explained on column 7, lines 48-column 8, line 8]

Akiyama does not explicitly disclose

- deleting the copy enabling information after copying the content.

However, In the same field of endeavor, **Qawami** discloses

- In step 225, a portion of the track is played back. This portion may be in

any of the files that comprise the track. In step 225a, the media unique key

(K.sub.mu) is calculated once again. **In step 225b, the encrypted title key**

stored in local memory is decrypted. Then, in step 225c, the title key is used

to decrypt the content from the buffer of device 15 containing content from the

user area 41 of card memory card 13. **Immediately after the buffer is**

decrypted, the title key is deleted in step 225d and **the media unique key**

is deleted in step 225e. The order of steps 225d and 225e is not important, but

it is important that both keys are only exposed for the time it takes to

completely read/copy a portion of the track. Thus after the track is

read/copied the key is deleted. [Paragraph 0058 and also see claim 1]

It would have been obvious to one having ordinary skill in the art, at the time

the invention was made, to combine the features of deleting the copy enabling

information/key after copying the content as per teachings **Qawami** into the

method as taught by **Akiyama** in order to limit the number of times the content

can be used.

8.   **As per claim 2, Akiyama discloses a copy management system, as applied**

    to claims above. Furthermore Akiyama discloses the system wherein the server

device transmits the

copy enabling information only once against one media identification

information.[Abstract]

9.   **As per claims 4 and 11,** Akiyama discloses a copy management system, as

applied to claims above. Furthermore **Akiyama** discloses the system wherein the server

device transmits the copy enabling information encrypted by the device identification

information, and the user terminal device decrypts the encrypted copy enabling

information with the device identification information.[figure 7, ref. S13-S15]

10.   **As per claims 6 and 13,** Akiyama discloses a copy management system, as

    applied to claims above. Furthermore **Akiyama** discloses the system wherein the

server device transmits an encryption key for encrypting the content to be

copied; the user terminal device encrypts the content using the encryption key

and copies the encrypted content to the first storage device, stores the

encryption key in a predetermined storage means, and decrypts the content

copied to the first storage device with the encryption key. [Figure 7]

11.   **As per claim 7,** Akiyama discloses a copy management system, as applied to

    claims above. Furthermore **Akiyama** discloses the system wherein the server

device stores as media identification information that transmission of the copy

enabling information is complete in a database, in a state of being associated

with device identification information attached to each user's user terminal

device, and overwrites old device identification information registered in the

database with modified device identification information when the device

identification information of the user terminal device is modified due to repair or

exchange.[Figure 1, reference "user profile database"; column 7, lines 47-48; the

registration of software identifier is disclosed and overwriting and modifying of

old identification such as software identifier DID should be inherently included

in the database registration]

12.   **As per claim 8-9, 30-32** **Akiyama** discloses a copy management system, as

applied to claims above. Furthermore Akiyama discloses the system wherein the

server device performs predetermined charge processing against a user who

owns the user terminal device to which transmission of the copy enabling

information is performed.[figure 8, see "request for billing"]

Conclusion

13.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed

within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the

advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a)

will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from
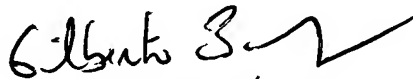
the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Samson B Lemma whose telephone number is

571-272-3806. The examiner can normally be reached on Monday-Friday (8:00

am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax

phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private

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direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

SAMSON LEMMA
S·L.
06/16/2006

GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100